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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of

Chad A. Stevens

Serial No. 09/888,215

Filed: June 21, 2001

For: Electrostatic Window Sticker Print
Medium and Methods of Making
and Using Same

Group Art Unit: 2853

Examiner: HUFFMAN, Julian D.

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply Brief under Rule 41.41 in response to the Examiner's Answer of
October 21, 2004.

Appellant notes that the § 112, first paragraph, rejection of claims 16-19 and 25 has
been withdrawn in the Examiner's Answer of October 21, 2004. Consequently, this rejection
is not longer at issue in this appeal.

The remaining issues are:

- (1) Whether claims 12-14 are anticipated under 35 U.S.C. § 102(b) by Floegel.
- (2) Whether claims 12-15 are anticipated under 35 U.S.C. § 102(b) by Longtin.
- (3) Whether claims 1, 9 and 10 are unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Floegel and Chamberlain.
- (4) Whether claims 16-19 are unpatentable under 35 U.S.C. § 103(a) over the combined teachings Chamberlain and Greenberg.
- (5) Whether claim 25 is unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Rubino and Greenberg.

Please refer to Appellant's Brief, if necessary, for the patent numbers of the cited prior art references, all of which are U.S. Patents.

With regard to the rejection of claims 12-14 as anticipated under 35 U.S.C. § 102(b) by Floegel, Appellant has previously noted that Floegel fails to teach or suggest the claimed “electrostatic charge deposited on a side of said sticker print medium; and a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium.” Rather, Floegel teaches an electret sheet having a “permanent electrostatic charge” that is a characteristic of the material and a result of the processing from which the sheet is made. (Col. 1, lines 57-63).

According to the Examiner's Answer, “[s]ince the claim is an apparatus claim, only limitations which further limit the structure of the sheet can further limit the claim. The limitation ‘deposited on a side of the sticker medium’ is a limitation directed towards the method of manufacturing the sheet, not the structure of the sheet.” (Examiner's Answer, p. 10). Appellant respectfully disagrees.

Obviously, the location and nature of a claimed element are structural features, particularly where, as here, the location of the feature impacts other structural elements of the apparatus. In this instance, the nature and location of the charge also leads to the recitation of “a protective backing over said electrostatic charge.” Obviously, such a backing is a “structural” feature. Thus, in Appellant’s claim, the location of the charge dictates the nature of the charge, the method of manufacture, and other structural features of the device, i.e., a protective backing.

In contrast, Floegel teaches an electret sheet with a permanent electrostatic charge. Floegel does not teach or suggest a charge that is “deposited” on one side of the medium, may be dissipated and is covered by a protective backing. Floegel does teach a “backing sheet” 14, but this backing sheet is not “over” the electrostatic charge on the side of the medium as claimed. Rather, the Floegel “backing sheet” prevents the plastic sheets from sticking to each other and prevents jamming of the plastic sheet in a printer. (Col. 4, lines 27-31). The “backing sheet” taught by Floegel has no interaction or relationship with the electrostatic charge as recited in Appellant’s claim.

The Examiner’s Answer lastly tries to argue the Floegel’s method of heating a plastic sheet and imparting a permanent charge to the heated material by exposing it to an electric field is the same as depositing a charge on a “side” of the sheet as claimed by Appellant. This is obviously incorrect. One of skill in the art would never confuse a deposited charge and its characteristics with a permanently charged electret material as recited by Floegel.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, Floegel cannot anticipate

claim 12. Thus, the rejection of claim 12 and its dependent claims, based solely on Floegel, should not be sustained.

With regard to the rejection of claims 12-15 as anticipated under 35 U.S.C. § 102(b) by Longtin, Appellant has previously pointed out that Longtin also fails to teach or suggest “an electrostatic charge deposited on a side of said sticker print medium.” According to the Examiner’s Answer, Longtin teaches the claimed deposited charge at col. 3, lines 6-9. However, this portion of Longtin merely describes the labels as “static cling” labels and does not teach or suggest a charge being deposited on a side of the labels as claimed. For at least this reason, the rejection of claims 12-15 based on Longtin should not be sustained.

Moreover, Longtin fails to teach or suggest “a blank sheet of electrostatic print medium” with a protective backing. To meet the terms of claim 12, Longtin must teach a print medium that is *simultaneously* blank, covered on one side by a deposited electrostatic charge and joined with a protective backing over that charge.

The Examiner’s Answer argues that Fig. 1 of Longtin shows such a print medium. This is demonstrably incorrect and disregards the corresponding text of Longtin.

Had the Examiner’s Answer considered the text of Longtin regarding Fig. 1, it would have been noted that Fig. 1 illustrates “a dispenser 12 on a wall 14 of a commercial business such as an auto repair shop.” (Col. 2, lines 55-60). “Each assembly 15 is peeled off of the carrier substrate 20 when a static cling label is desired for use.” (Col. 2, lines 65-66). Thus, it is inescapably clear that Fig. 1 illustrates finished *printed* labels that are ready for use in a commercial business. The fact that the printing is not illustrated in Fig. 1 is entirely immaterial. By disregarding the text of Longtin, the Examiner’s Answer seeks to read teachings into Fig. 1 that are clearly not there.

Additionally, the Examiner's Answer makes the statement that "Longtin states that the backing is necessary to protect the sheet during manufacturing." (Examiner's Answer, p. 12, lines 7-8). Appellant can find no such statement in Longtin, however, and the Examiner's Answer does not indicate where Longtin makes such a statement.

The truth is that Longtin does not ever mention whether the labels are printed and then applied to the backing or vice versa. Those of skill in the art would understand that the conventional process is to print the labels and then apply them to a backing, and would understand Longtin in this manner. It is Appellant's innovation that a blank medium is given a backing so that it can be printed as desired by an end consumer. In any event, the Office has not met its burden of demonstrating that Longtin necessarily teaches a blank electrostatic medium with a protective backing. *In re Robertson*, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999)

In sum, there simply is no teaching or indication in Longtin that at some point the stickers were blank, charged and on a protective backing. Thus, the rejection of claim 12 and its dependent claims, based solely on Longtin, should not be sustained.

With regard to the rejection of claims 1, 9 and 10 as being unpatentable over the combined teachings of Floegel and Chamberlain, Appellant has previously argued that Floegel and Chamberlain cannot be combined to teach "depositing an electrostatic charge on said sticker print medium with a charge donor," where the "charge donor is separate from, and not a part of, the sticker print medium." As given in the Examiner's Answer, the motivation to combine the teachings of these two references would have been to increase the strength of attraction or adhesion when mounting the medium. However, this would not be the effect of combining the teachings of Floegel and Chamberlain as proposed.

As noted above, Floegel teaches an electret material with a permanent electric charge. Under the most basic principles of electrostatics, this “permanent electrostatic charge” will repel any like charge. Consequently, if a “charge donor” were brought into contact with the electret sheet taught by Floegel, the permanent electrostatic charge in the sheet would repel and prevent the addition of any further like charge from the charge donor.

According to the Examiner’s Answer, we may overlook Coulomb’s law in this instance because Chamberlain mentions “Pliofilm” (U.S. Patent No. 1,989,632) and “Koroseal” (U.S. Patent No. 1,929,453) which “inherently carry an electric charge.” (Col. 1, lines 24-28). This, however, merely refers to the fact that these types of material tend to collect a charge from their environment, that is why they accept charge from a donor. The cited materials are *not* electret materials, as the Examiner’s Answer alleges, and do not have a permanent electrostatic charge as does the material taught by Floegel.

Appellant has reviewed the two patents cited by Chamberlain as teaching “Pliofilm” and “Koroseal,” U.S. Patent Nos. 1,989,632 and 1,929,453. Neither describes the production of an electret material with a permanent electrostatic charge.

Thus, Applicant respectfully submits that Coulomb’s law does apply. Consequently, a separate charge donor as taught by Chamberlain could not be used to increase the strength of the charge on the sheet taught by Floegel. The use of a charge donor with the sheet taught by Floegel would not be attempted by one of ordinary skill in the art. Therefore, there is no motivation in the prior art to combine the teachings of Floegel and Chamberlain as suggested in the final Office Action.

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992)." M.P.E.P. § 2143.01 (emphasis added). Consequently, the rejection of claims 1 and 10 based on the improperly combined teachings of Floegel and Chamberlain should not be sustained. The same applies to the rejections of claims 2-4 and 9 which depend from claim 1 and which were also rejected based on the proposed combination of Floegel and Chamberlain.

Regarding the rejection of claims 16-19 under 35 U.S.C. § 103(a) over the combined teachings of Chamberlain and Greenberg, Appellant notes that claim 16 recites an "electrostatic sticker kit comprising" "at least one blank sheet of an electrostatic sticker print medium; and a charge donor" "wherein said at least one blank sheet of sticker print medium and said charge donor are packaged together in said kit. In contrast, the combination of Chamberlain and Greenberg fail to teach or suggest the claimed kit.

Specifically, Chamberlain fails to teach or suggest a "blank sheet of electrostatic sticker print medium." According to the Examiner's Answer, Chamberlain teaches a blank sheet at Fig. 3a. This is incorrect. Chamberlain's Fig. 3a is intended only to illustrate the structure of the sheet (col. 2, lines 28-29). Consequently, no printing is illustrated. The Examiner's Answer would like to read into this a teaching of a blank sheet. To the contrary, there is no teaching or suggestion in Chamberlain of blank sheets. Rather, one of skill in the art reading Chamberlain in its entirety would readily understand that Chamberlain is exclusively describing printed "decorative sheet material." (Col. 1, line 1). This is the same game that was played above with Longtin. Chamberlain fails to teach or suggest a "blank sheet of electrostatic sticker print medium."

Moreover, neither reference teaches or suggests the claimed materials packaged together into a kit. Simply because Greenberg teaches photographic plates in a kit does not suggest that that a blank sheet of electrostatic sticker print medium and a charge donor should be packaged together in a kit. There is no such suggestion in the references taken alone or together of the claimed kit in which a blank sticker print medium and a charge donor are packaged together.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, this rejection of claims 16-19 should not be sustained.

Regarding the rejection of claim 25 under 35 U.S.C. § 103(a) over the combined teachings Rubino and Greenberg, claim 25 recites:

A business method comprising providing an electrostatic sticker kit, said providing an electrostatic sticker kit comprising providing a kit containing at least one blank sheet of an electrostatic sticker print medium and a charge donor, other than said sticker print medium, for depositing an electrostatic charge on either side of said sticker print medium, wherein said at least one blank sheet of an electrostatic sticker print medium and said charge donor are packaged together to form said kit.

In contrast, Rubino and Greenberg fail to teach or suggest the claimed business method of providing an electrostatic sticker kit. Rubino is cited as teaching the claimed blank sheet of electrostatic sticker *print* medium, but does not. Rather, Rubino teaches an "electrostatically chargeable intermediate sheet" (abstract) that is used to adhere another sheet or object to a support surface. This is clearly *not* a teaching of an electrostatic sticker print medium on which a purchaser would print a sticker image.

The Examiner's Answer seeks to disregard the teachings of Rubino that the sheet being described in an "intermediate" sheet used to adhere something else to a support surface and is not printed. That, however, is impermissible. A reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that point toward the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). Rubino does not teach or suggest a blank sheet of electrostatic sticker print medium as claimed.

Similarly, as noted above, Greenberg also fails to teach or suggest a blank sheet of electrostatic sticker print medium or a kit that is offered in a business method as claimed. Consequently, the combination of Rubino and Greenberg cannot teach or suggest the claimed business method of providing a kit including a blank sheet of electrostatic sticker print medium and a charge donor. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, this rejection of claim 25 should not be sustained.

In view of the foregoing, it is submitted that the final rejection of the pending claims is improper and should not be sustained. Therefore, a reversal of the Final Rejection is respectfully requested.

Respectfully submitted,



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Title: Electrostatic Window Sticker Print Medium and Methods of Making and Using Same

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TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in **triplicate** is the Reply Brief with respect to the Examiner's Answer mailed on Oct. 21, 2004. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

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